

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants note that they have made some purely editorial changes to claims 10 and 11, and have also added new claims 19 and 20, which are supported by claim 10. Applicants do not believe any of the amendments introduce new matter. An early notice to that effect is earnestly solicited.

Claims 10-16 were rejected under 35 USC § 103(a) as being obvious over WO 2004/024708. In response, Applicants respectfully submit that the WO is not competent prior art. It is neither a US patent, nor a US application published under 35 USC § 122(b), and consequently, does not qualify as prior art under 35 USC § 102(e). Rather, it qualifies as prior art, if at all, under 35 USC § 102(a), which would make it prior art as of its publication date of March 25, 2004. Since this date is already after the filing date of the instant application of September 24, 2003, WO 2004/024708 is not prior art against the present claims.

The Examiner may want to consider whether the application published as WO 2004/024708 has been nationalized and published under 35 USC § 122(b). Such an application would be applicable under 35 USC § 102(e) as of the international filing date of September 12, 2003, since the WO was published in English. However, the instant application claims priority from DE 10244811 filed on September 26, 2002, and, therefore, can antedate this reference upon the filing of a certified English translation of the DE.

Applicants note that the Examiner comments at the top of page 10 of the Office Action dated October 17, 2005, that “[e]ven if Certified English Translation will be presented, the effective *priority benefit* of WO 2004/024708 is 9/16/2002 prior to the benefit of the instant application.” However, absent an interference, foreign priority of a reference is not a consideration. Thus, 35 USC §§ 102(a) and (b) make WO 2004/024708 prior art as of its publication date of March 25, 2004. 35 USC § 102(e) makes the national stage counterpart prior art as of its effective US filing date, which, because the WO was published in English, would make the effective US filing date the international filing date of September 12, 2003. No other section is pertinent, and, thus, none would make the WO or the national stage counterpart prior art as of its foreign filing date. Such foreign priority of the reference is only taken into account under 35 USC § 102(g) in considering an interference.

In view of the foregoing, Applicants submit that this rejection clearly is in error and must be withdrawn. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 10-16 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants submit that the term “converting” would be readily understood by any person having ordinary skill in the art, and, therefore, the use of the term is not confusing. Indeed, the term appears in the claims of over **71,000** issued U.S. patents, and, thus, is a term of common usage, commonly accepted by the Patent Office. Second, clause (c) expressly states that the conversion of formula (IV) to formula (VI) is “by reduction,” and, therefore, the step of “converting * * * by reduction” is, in fact, recited. Finally, clause (a) claims the conversion of formula I to formula II, and, thus, such step is not, in fact, missing.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 10-16 were rejected under 35 USC § 112, first paragraph, as being broader than the enabling disclosure in embracing compounds wherein heteroaryl is a 7 to 10-membered ring. In response, Applicants point out that examples of species meeting this definition are set forth at page 6, lines 18-19, namely indolyl, indazolyl, benzofuranyl, benzothiophenyl, quinolinyl or isoquinolinyl. Further, the presence or absence of working examples is only one factor to be taken into consideration in determining enablement. The Examiner has given no reason, other than the absence of working examples, why a person skilled in the art should not be able to practice the full scope of the invention as claimed. Indeed, the Examiner takes the position in connection with the obviousness rejection that the choice of heteroaryl would not be expected to affect the course of the reaction. This is completely at odds with the notion that the heteroaryl group is somehow critical, thereby requiring working examples in order for a person skilled in the art to practice the invention. In the absence of such reason, the Examiner has not made out a *prima facie* case of lack of enablement.

Respectfully, this rejection is untenable, and Applicants respectfully request that the Examiner reconsider and withdraw it as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 10-16 were rejected under 35 USC § 112, first paragraph, as being broader than the enabling disclosure in embracing compounds wherein W is CN. In response, Applicants point out that Example 3 at the bottom of page 21 describes an example wherein W = CN.

Moreover, as noted above, the presence or absence of working examples is only one factor to be taken into consideration in determining enablement. The Examiner has given no reason, other than the absence of working examples, why a person skilled in the art should not be able to practice the full scope of the invention as claimed. In the absence of such reason, the Examiner has not made out a *prima facie* case of lack of enablement.

Respectfully, this rejection is untenable, and Applicants respectfully request that the Examiner reconsider and withdraw it as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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